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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91223663
Party	Defendant Vincent Giovannetti
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

Salt Life, LLC)	Opposition No.: 91223663
)	
Plaintiff,)	
vs.)	
)	
Giovannetti, Vincent)	
)	
Defendant)	
)	
)	
)	
)	

MOTION TO DISMISS

Defendant Vincent Giovannetti, (“Defendant” or “Applicant”), through his attorney, Anthony M. Verna III, hereby files this Motion to Dismiss based upon Fed.R.Civ.P. 12(b)(6) for a failure to state a claim against the Notice of Opposition that Salt Life, LLC (“Plaintiff” or “Opposer”) filed against Defendant’s trademark application, U.S. Serial No. 86592650, SALT PRO.

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I. Facts

Applicant Vincent Giovannetti is an individual who filed SALT PRO on April 9, 2015. SALT PRO represents goods/services of “Board shorts; Hats; Sweaters; T-shirts; Tank tops” in International Class 25.

Opposer Salt Life, LLC owns various trademark registrations, such as SALT LIFE, in word and stylized format, for varying goods/services, filed at various different times.

II. The Standard of a Motion to Dismiss

A motion to dismiss under Fed.R.Civ.P. 12(b)(6) is a test of the sufficiency of a complaint. See TBMP Section 503.01 (3d ed. 2011). To survive such a motion, a plaintiff need only allege sufficient factual matter as would, if proved, establish that (1) the plaintiff has standing to maintain the proceeding, and (2) a valid ground exists for opposing or cancelling the mark. *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 187 (CCPA 1982). Also see *Young v. AGB Corp.*, 152 F.3d 1377, 47 USPQ2d 1752, 1754 (Fed. Cir. 1998); TBMP § 503.02 (3d ed. rev. 2012).

Specifically, “a complaint must contain sufficient factual matter, accepted as true, to state a claim to relief that is plausible on its face.” To survive a motion to dismiss, a complaint must contain sufficient factual matter, accepted as true, to state a claim to relief that is plausible on its face. *Ashcroft v. Iqbal*, 556 U.S. 662, 129 S.Ct. 1937, 1949-50 (2009), quoting *Bell Atlantic Corp. v. Twombly*, 550 U.S. 544, 570 (2007). A pleading must contain a “short and plain statement of the claim showing that the pleader is entitled to relief.” Specifically a complaint, or counterclaim, “must contain sufficient factual matter, accepted as true, to ‘state a claim to relief that is plausible on its face.’” *Doyle v. Al Johnson's Swedish Restaurant & Butik, Inc.*, 101 USPQ2d 1780, 1782 (TTAB 2012) quoting *Ashcroft v. Iqbal* at 678.

Any defendant to a complaint, counterclaim, or crossclaim may move to dismiss under Fed.R.Civ.P. 12(b)(6) for failure to state a claim upon which relief can be granted. The party moving for dismissal has the burden of showing that no claim has been stated.

During this threshold review, [t]he issue is not whether a plaintiff will ultimately prevail but whether the claimant is entitled to offer evidence to support the claims.

In the context of *inter partes* proceedings before the Board, a claim has facial plausibility when the opposer or petitioner pleads factual content that allows the Board to draw a reasonable inference that the opposer or petitioner has standing and that a valid ground for the opposition or cancellation exists. Cf. *Twombly*, 550 U.S. at 556, 127 S.Ct. at 1955.

In particular, a plaintiff need only allege "enough factual matter ... to suggest that [a claim is plausible]" and "raise a right to relief above the speculative level." *Totes/Isotoner Corp. v. U.S.*, 594 F.3d 1346, 1354 (Fed. Cir. 2010).

Moreover, if the opposer has provided notice pleading of a claim under Trademark Act Section 2(d), 15 U.S.C. § 1052(d), by alleging (1) priority, based on its ownership of pleaded registrations and pending applications filed prior to the filing date of the defendant's involved application; and (2) likelihood of confusion between the marks at issue, then the opposer has done enough. See Trademark Act Section 7(c), 15 U.S.C. § 1057(c); *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974); *Zirco Corp. v. American Telephone and Telegraph Co.*, 21 USPQ2d 1542 (TTAB 1991).

III. Plaintiff/Opposer has not met its burden

The power of the Trademark Trial and Appeal Board comes from 15 U.S.C. § 1067 (Section 17 of the Lanham Act). Specifically, 15 USC § 1067(a) states "In every case of interference, opposition to registration, application to register as a lawful concurrent user, or application to cancel the registration of a mark, the Director shall give notice to all parties and

shall direct a Trademark Trial and Appeal Board to determine and decide the respective rights of registration.”

The Plaintiff in this particular proceeding has not met its burden in writing a Notice of Opposition.

The Plaintiff appears to have two legal theories: 1) Likelihood of Confusion and 2) Trademark Dilution.

a. Likelihood of Confusion

The Plaintiff has alleged adjectives of “famous” and “significant goodwill” ¶6 of the Notice of Opposition. However, these are but conclusory expressions as Plaintiff has not attempted to identify with appropriate and necessary detail the characteristics of what is “famous” or how there’s “significant goodwill” about the SALT LIFE marks.

To summarily declare its marks “famous” or with “significant goodwill” is admittedly an attribute that is permitted a registered trademark owner, but in this instance it comes with little explanation in the pleading.

The plaintiff also pleads that common-law rights exist. ¶5 of the Notice of Opposition. In order to properly allege superior proprietary rights for a plaintiff relying on common law rights, the plaintiff must also plead priority of use or “use analogous to trademark use” *Wella Corp. v. Clairol, Inc.*, 169 U.S.P.Q. 190 (T.T.A.B. 1971) and either the inherent or acquired distinctiveness of its mark. In the case of acquired distinctiveness, the opposer must allege facts sufficient to show, if proven, that the ordinary consumer associates the mark with a “single, though anonymous source.” *See* J. T. MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 15.8 (2004).

The complaint should then set forth the basic facts supporting plaintiff's claim of likelihood of confusion. These include, as applicable, allegations as to the similarity of the marks in sight, sound, and/or meaning; similarity of the goods and/or services; similarity of trade channels and classes of purchasers of the goods and/or services; the fame of plaintiff's mark; the similarity of the conditions under which buyers encounter plaintiff's and defendant's marks; and the nature and extent of any actual confusion. *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 U.S.P.Q. 563 (C.C.P.A. 1973).

The Notice of Opposition, besides not being in a short and plain statement and numbered paragraphs, tries to mention a few key points under the Lanham Act and the theory of a likelihood of confusion under §2(d), 15 U.S.C. §1052(d), but never truly spells out the theory or in the proper format.

In this particular case, the Plaintiff ignores a key factor and only talks about the trademarks involved.

In order to state properly a claim of likelihood of confusion, a plaintiff must plead that (1) the defendant's mark, as applied to its goods or services, so resembles the plaintiff's mark or trade name as to be likely to cause confusion, mistake, or deception; and (2) priority of use. *See King Candy Co., Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974)

This means that the Trademark Trial and Appeal Board must speculate on the legal theory that the Plaintiff believes he will be harmed under. To survive a motion to dismiss, the factual allegations of a complaint "must be enough to raise a right to relief above the speculative level" and the complaining party must offer "more than labels and conclusions" or "a formulaic recitation of the elements of a cause of action." *Bell Atl. Corp.* at 555.

It would be nice if Plaintiff reached to that level. Alas, the Plaintiff did not do that at all. The Plaintiff does not allege even labels or conclusions. “[W]here the well-pleaded facts do not permit the court to infer more than the mere possibility of misconduct, the complaint has alleged — but it has not ‘show[n]’ — ‘that the pleader is entitled to relief.’”; *Iqbal*, 556 U.S. at 679 (quoting Fed.R.Civ.P. 8(a)(2)). (And in *Iqbal*, the Plaintiff had a well-pleaded facts section. The pleading in this proceeding is not adequate to cover any facts or legal theory.)

In ruling upon a motion based upon Fed.R.Civ.P. 12(b)(6), the Court may also properly consider matters that can be judicially noted under Rule 201 of the Federal Rules of Evidence. *Solid Host v. Namecheap*, 652 F.Supp.2d at 1099 (CD Cal 2009).

A determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, at 567. See also *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). Therefore, an assessment of whether the Plaintiff has made a prima facie case for likelihood of confusion will consider the same factors. In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) (“The fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.”).

In this particular instance, the Plaintiff has pleaded that the marks are famous and that is likely to cause confusion. The Plaintiff failed to plead *how* the marks are famous. The Plaintiff has failed to plead *how* Applicant’s mark resembles the Plaintiff’s marks. The Plaintiff’s Notice of Opposition is completely conclusory.

Plaintiff does not make any link between its registrations and the Applicant's mark or the goods/services the various marks represent.

b. Trademark Dilution

In order to prove trademark dilution, the plaintiff must prove:

- (1) that plaintiff owns a famous mark that is distinctive;
 - (2) the defendant is using a mark in commerce that allegedly dilutes the plaintiff's famous mark;
 - (3) the defendant's use of its mark began after the plaintiff's mark became famous;
- and
- (4) the defendant's use of its mark is likely to cause dilution by blurring.

Coach Services Inc. v. Triumph Learning LLC, 668 F.3d 1356, 101 USPQ2d 1713, 1723-24 (Fed. Cir. 2012).

Opposer's assertion of dilution under Section 43(c) of the Trademark Act of 1946, 15 U.S.C. § 1125(c) in the pleading is deficient in as much as opposer did not plead how its marks have become famous; how its marks are distinctive; and how blurring will take place.

In fact, the plaintiff didn't even plead that its marks are distinctive in any aspect.

In addition, the fame that must attach to a mark for it to be eligible under the dilution provisions of the Trademark Act is greater than that which qualifies a mark as famous for the du Pont analysis of likelihood of confusion. *Toro Co. v. ToroHead Inc.*, 61 USPQ2d 1164 at 1170 (TTAB 2001), citing *I.P. Lund Trading ApS v. Kohler Co.*, 163 F.3d 27, 47 USPQ2d 1225, 1239 (1st Cir. 1998) (“[T]he standard for fame and

distinctiveness required to obtain anti-dilution protection is more rigorous than that required to seek infringement protection.”).

A mark is famous if it “is widely recognized by the general consuming public of the United States as a designation of source of the goods or services of the mark's owner.” 15 U.S.C. § 1125(c)(2)(A). By using the “general consuming public” as the benchmark, the TDRA eliminated the possibility of “niche fame,” which some courts had recognized under the previous version of the statute. See *Top Tobacco, LP v. N. Atl. Operating Co.*, 509 F.3d 380, 384 (7th Cir.2007) (noting that the reference to the general public “eliminated any possibility of ‘niche fame,’ which some courts had recognized before the amendment”).

In this case, ¶9 of the Notice of Opposition uses the word “dilution,” but doesn’t explain the term. The Plaintiff is, again, writing a Notice of Opposition to be vague. If the Plaintiff means that its marks are famous to the general consuming public, why doesn’t it say so? Probably because the marks are not. Neither does the Plaintiff assert exactly how its marks became famous. Regardless, the Plaintiff comes to a conclusion, hoping one sentence is sufficient, instead of pleading why the Plaintiff’s marks are famous.

Those marks must be famous AND distinctive. Distinctiveness – or lack thereof – was discussed above. “To be vulnerable to dilution, a mark must be not only famous, but also so distinctive that the public would associate the term with the owner of the famous mark even when it encounters the term apart from the owner’s goods or services, i.e., devoid of the trademark context.” *Toro* at 1177.

An example of a mark that is famous but not very distinctive is CLUE: “[it] may have significant recognition and renown to the extent that purchasers of board games would be very familiar with it. But it was found not to be very distinctive in the marketplace in general.” *Toro* at 1177.

Opposer’s trademarks are not well-known in the apparel industry.

Trademark dilution must fail because the plaintiff has not pleaded how its marks became famous, what’s distinctive – if anything – about its marks,

IV. Conclusion

The Plaintiff has a duty when filing pleadings to make allegations that rise beyond mere speculation. The plaintiff must state a claim upon which relief may be granted. Plaintiff’s Notice of Opposition fails to state any claim upon which relief may be granted. The Plaintiff does not link its goods/services to the Applicant’s goods/services. The Plaintiff does not fully plead how consumers would be confused if the Applicant’s mark on Applicant’s goods/services when compared to the Plaintiff’s marks on the Plaintiff’s goods/services. The Plaintiff also did not fully plead trademark dilution. The Plaintiff comes to the conclusion that the Plaintiff’s marks are famous, but does not plead how those marks are famous or distinctive. The Plaintiff also did not discuss how its marks would be blurred.

For these reasons, the Board should grant the motion to dismiss; dismiss this opposition; and allow the Applicant’s mark, SALT PRO, to register.

Respectfully submitted,

Dated: September 25, 2015

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that on this 25th day of September, 2015, a copy of the foregoing Motion was served via First Class Mail, postage prepaid, on the following:

J. Parks Workman
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Respectfully submitted,

Dated this September 25, 2015

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